

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: RICCARDI1A

In re Application of:) Art Unit: 1632
RICCARDI et al.)
Examiner: L. D. Lieto
Appln. No.: 10/630,926) Washington, D.C.
Date Filed: July 31, 2003) Confirmation No. 7576
For: INTRACELLULAR MODULATORS) April 25, 2005
OF APOPTOTIC CELL DEATH)

RESPONSE

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building, Mail Stop **Amendment**
401 Dulany Street
Alexandria, VA 22314

Sir:

This communication is responsive to the Office Action of January 25, 2005, primarily in the nature of a requirement for restriction. A petition and payment for a two month extension of time are attached hereto.

The examiner has required restriction to one of the inventions (Groups I-V) as set forth in the Office Action. Applicants elect with traverse Group V, drawn to a GILR transgenic mouse and a method for screening compounds having glucocorticoid-related effects using a GILR transgenic mouse and presently comprising claims 3, 4, 17 and 18.

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The traversal of the requirement for restriction is made only insofar as Groups II and V are concerned. The claims of Groups II and V are related as a product, a process for making the product and a process for using the product. MPEP 806.05(i) states:

(b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

The MPEP §806.05(i) also states:

Where the product claims are allowable (i.e., novel and nonobvious), restriction may be required only where the process of making and the product made are distinct (MPEP §806.05(f)); otherwise, the process of using must be joined with the process of making and product made, even if a showing of distinctness can be made between the product and process of using (MPEP §806.05(h)).

Although the examiner has stated in the middle of page 4 of the Office Action that "since the product is not allowable, restriction is proper between said method for making and method of using", it should be noted that no examination of the product claims 3 and 4 has been conducted and therefore, it is undetermined at this point whether or not the product claims are allowable. The examiner has certainly not established that the

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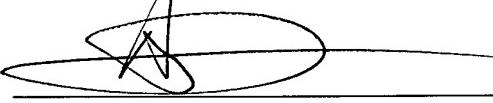
product is not allowable. By traversing insofar as Groups II and V are concerned, applicants submit that the process of making and the product made are not patentably distinct.

The examiner has stated that "the mouse of group V can be made in a different way than the method of group II, such as nuclear transfer". Applicants respectfully disagree with the examiner's position, as a nuclear transfer process does not correspond to a method of making a transgenic mouse but rather to a method of cloning a mouse. Applicants submit that the process of making and the product made are not distinct and should be kept together and examined in a single group along with the process of using. Accordingly, the examiner is requested to withdraw the restriction requirement insofar as Groups II and V are concerned and examine Groups II and V together for the reasons discussed above. Reconsideration and examination of both Groups II and V are respectfully solicited.

Respectfully submitted,

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